

REMARKS

This Application has been carefully reviewed in light of the Office Action dated June 14, 2007 ("Office Action"). At the time of the Office Action, Claims 1-5, 7, 8, and 10-28 were pending and Claims 17-28 were withdrawn. The Examiner rejects Claims 1-5, 7, 8, and 10-16. Applicant amends Claim 12 and adds new Claims 29-32. Applicant submits that no new matter has been added by these amendments. As described below, Applicant believes all claims to be allowable over the cited references. Therefore, Applicant respectfully requests reconsideration and full allowance of all pending claims.

Double Patenting

The Examiner provisionally rejects Claims 1-5, 7, 8, and 10-16 under the judicially created doctrine of obviousness-type double patenting. Specifically, Claims 1-5, 7, 8, and 10-16 are rejected as being unpatentable over Claim 1 of copending Application No. 09/817,353 in view of U.S. Patent Application Publication No. 2002/0010634 A1 issued to Roman et al. ("Roman") and U.S. Patent Application Publication No. 2001/0032143 A1 issued to Haseltine ("Haseltine"). As this is a provisional double patenting rejection, Applicant defers the decision to file a terminal disclaimer or traverse the rejection until the Examiner has indicated that both the present Application and copending Patent Application 09/817,353 include allowable subject matter. However, Applicant stands willing to file a Terminal Disclaimer with respect to these claims in their current form upon indication of their allowability.

Section 102 Rejections

The Examiner rejects Claims 1-2, 7-8, 13, and 15 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,980,962 issued to Arganbright et al. ("Arganbright"). Applicant traverses these rejections for the reasons discussed below.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987); MPEP § 2131. In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim." *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15

U.S.P.Q.2d 1566 (Fed. Cir. 1990); MPEP § 2131 (*emphasis added*). Whether considered alone or in combination with any other cited references, *Arganbright* does not disclose, either expressly or inherently, each and every element of the Applicant's claims. For example, at least the following claimed aspects of independent Claim 1 are not disclosed, taught, or suggested by *Arganbright*:

- in response to receiving the electronic request from the customer, accessing a database to obtain transaction information associated with the customer, the transaction information identifying at least one item of merchandise having been purchased by the customer in a prior purchase transaction; and
- displaying, to the customer via the web access tool, the transaction information comprising a list of the at least one item of merchandise having been purchased by the customer in the prior purchase transaction.

The deficiency of the disclosure of *Arganbright* with respect to each of these claim elements is discussed below.

According to *Arganbright*, the process for handling returns begins when "the system presents the user with a copy of the satisfaction guarantee 2702." (Column 63, lines 3-5). Thus, the process initiates with the presentation of the return policy to the user. "After the user has a chance to review satisfaction guarantee 2702, the user selects whether the user wishes to "return" or "exchange" (box 2704) an item or plurality of items." (Column 63, lines 8-11). From this point forward, *Arganbright* discloses two distinct but related processes: one for returns and one for exchanges/replacements. However, in either case, the first electronic request received from the user relating to the return of a product is the selection of either a "return" button or an "exchange" button.

"If the user selects "return," an online return form 2706 is presented to the user." (Column 63, lines 12-13). "The user is then requested to enter a plurality of information (box 2708) on return form 2706, including but not limited to, quantity, stock number or SKU, the reason for the return, product description, and an invoice number." (Column 63, lines 13-17). In contrast, "[i]f the user selects to "exchange" a product or products, the user is presented with an exchange form 2714." (Column 63, lines 36-37). Although two separate forms are

disclosed (i.e., “a return form 2706” and “an exchange form 2714,” the information requested from the customer by the two forms is very similar. In the return scenario, *Arganbright* discloses that the return form, once populated by the customer’s input, is “presented to the user in a format (box 2710) that can be printed on a conventional printer connected to the user’s computer” and that the user “is requested to print the form and include the form in the box containing the product or products to be returned.” (Column 63, lines 23-29). In the exchange scenario, the exchange form, once populated by the customer’s input is “forwarded to the marketing company by any method, including, but not limited to, email, regular mail, or telephone.” (Column 63, lines 51-54). There is no further disclosure in *Arganbright* with respect to the processing of the return beyond the point where the form is populated and delivered to the marketing company by either mail or email.

In either of the return or exchange scenarios, Applicant directs the Examiner’s attention to the fact that the information used to populate the appropriate form is requested from the customer. Thus, the form must be filled out by the customer. Accordingly, to the extent that the Examiner relies on the selection of either “return” or “exchange”, as disclosed in *Arganbright*, as being analogous to Applicant’s recited “electronic request requesting to initiate return processing,” Applicant respectfully submits that there is no disclosure in *Arganbright* of **“in response to receiving the electronic request from the customer, accessing a database to obtain transaction information associated with the customer . . . ,”** as recited in Applicant’s Claim 1, since *Arganbright* specifically states that the request and exchange forms are filled in by the user. Alternatively, to the extent that it is the Examiner’s position that sending the “exchange form” by email to the marketing company is analogous to Applicant’s recited “electronic request requesting to initiate return processing,” Applicant respectfully submits that there is no disclosure in *Arganbright* of **“in response to receiving the electronic request from the customer, accessing a database to obtain transaction information associated with the customer . . . ,”** as recited in Applicant’s Claim 1, since *Arganbright* does not disclose any further steps after the exchange form is sent to the service customer representative by email.

For similar reasons, Applicant respectfully submits that *Arganbright* also does not disclose, teach, or suggest “displaying, to the customer via the web access tool, the

transaction information comprising a list of the at least one item of merchandise having been purchased by the customer in the prior purchase transaction,” as recited in Applicant’s Claim 1. In both of the return and exchange scenarios, *Arganbright* states that the user is “requested to enter a plurality of information . . . including but not limited to, quantity, stock number or SKU, the reason for the return, product description, and an invoice number.” (Column 63, lines 13-17 and 36-37). There is no disclosure in either the return or exchange process that any information is gathered and displayed to the user. Accordingly, there is no disclosure in *Arganbright* of “displaying, to the customer via the web access tool, the transaction information comprising a list of the at least one item of merchandise having been purchased by the customer in the prior purchase transaction,” as recited in Applicant’s Claim 1.

Because *Arganbright* does not disclose, teach, or suggest each and every element recited in Applicant’s Claim 1, Applicant respectfully requests reconsideration and allowance of Claim 1, together with Claims 2, 7-8, 13, and 15 that depend on Claim 1.

Section 103 Rejections

The Examiner rejects Claims 3-5, 10-12, 14, and 16 under 35 U.S.C. 103(a) as being unpatentable over *Arganbright* in view of U.S. Patent Application Publication No. 2002/0010634 issued to Roman et al. (“*Roman*”). Applicant traverses these rejections for the reasons discussed below.

First, Claims 3-5, 10-12, 14, and 16 depend upon independent Claim 1, which Applicant has shown above to be allowable. Accordingly, dependent Claims 3-5, 10-12, 14, and 16 are not obvious over the various combinations of references relied upon by the Examiner at least because Claims 3-5, 10-12, 14, and 16 include the limitations of Claim 1. Additionally, dependent Claims 3-5, 10-12, 14, and 16 recite further elements that distinguish Applicant’s claims over the prior art of record. Since Applicant has shown independent Claim 1 to be allowable, however, Applicant has not provided detailed arguments with respect to Claims 3-5, 10-12, 14, and 16. Applicant remains ready to do so if it becomes appropriate.

Second, assuming for purposes or argument that the proposed combination discloses the limitations of Applicant's claims (which Applicant disputes above), the proposed *Arganbright-Roman* combination is improper because the Examiner has not provided the requisite teaching, suggestion, or motivation, either in the cited references or in the knowledge generally available to one of ordinary skill in the art at the time of Applicant's invention to modify or combine *Arganbright* in view of *Roman*.

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed above, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention. It is clear based at least on the many distinctions discussed above that the proposed *Roman-Haseltine* combination does not, taken as a whole, suggest the claimed invention, taken as a whole. Applicant respectfully submits that the Examiner has merely pieced together disjointed portions of references, with the benefit of hindsight using Applicant's claims as a blueprint, in an attempt to reconstruct Applicant's claims.

The governing Federal Circuit case law makes this strict legal standard clear.¹ According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding.” *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). “Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.” *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the “range of sources available . . . does not diminish the requirement for actual evidence.” *Id.* **Although a prior**

¹ Note M.P.E.P. 2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432 (emphasis added). See also *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (*holding a prima facie case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine*); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at” the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. See *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, “*The tendency to resort to ‘hindsight’ based upon applicant’s disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.*” M.P.E.P. § 2142 (emphasis added). The governing Federal Circuit cases are equally clear. “A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome *wherein that which only the invention taught is used against its teacher.*’” *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted; emphasis added). In *In re Kotzab*, the court noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. See *id.* See also, e.g., *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5

U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, *explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention*:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted; emphasis added).

In the *Office Action*, the Examiner speculates that "it would have been obvious to one of ordinary skill in art to incorporate the teachings of *Roman* into the disclosure of *Arganbright* in order to make it convenient for the user or customer to be able to retrieve and view their information." (*Office Action*, page 5). It appears that the Examiner has merely proposed alleged an advantage of combining *Arganbright* with *Roman* (an advantage which Applicant does not admit could even be achieved by combining these references in the manner the Examiner proposes). The Examiner has not pointed to any portions of the cited references, however, that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to incorporate the marketing system disclosed in *Arganbright* with the web-based fraud detection system disclosed in *Roman*. In other words, the alleged advantage of "mak[ing] it convenient for the user" does not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention (*without using Applicant's claims as a guide*) to combine the different systems disclosed in *Arganbright* and *Roman*; (2) how one of ordinary skill in the art at the time of Applicant's invention would have actually done so; and (3) how doing so would purportedly meet the limitations of Applicant's claims. Indeed, if it were sufficient for an Examiner to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine of modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not),

then virtually any two or more references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear and as discussed above, that is not the law.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claims 3-5, 10-12, 14, and 16.

New Claims 29-32

New Claims 29-32 have been added and are fully supported by the original specification. No new matter has been added. Applicant respectfully submits that the prior art of record does not disclose, teach, or suggest the elements disclosed in Applicant's Claims 29-32.

For example, new independent Claim 32 recites:

A method of using the Internet to provide return labels to customers for facilitating returns of merchandise, comprising the steps of:

receiving, from a customer, an electronic request via a web access tool associated with the customer, the electronic request requesting to initiate return processing of merchandise having been purchased by the customer in a prior purchase transaction;

in response to receiving the electronic request from the customer, accessing a customer profile associated with the customer, the customer profile comprising customer-specific credit information or customer-specific shipping information;

in response to receiving the electronic request from the customer, accessing a database to obtain transaction information associated with the customer, the transaction information identifying at least one item of merchandise having been purchased by the customer in a prior purchase transaction;

displaying, to the customer via the web access tool, the transaction information comprising a list of the at least one item of merchandise having been purchased by the customer in the prior purchase transaction;

receiving an electronic selection, from the customer, via the web access tool, the electronic selection identifying a particular item of merchandise having been purchased by the customer in the prior purchase transaction;

in response to receiving the electronic selection from the customer of the particular item of merchandise having been purchased by the customer in the prior purchase transaction, generating data for printing a

return label for the particular item of merchandise selected by the customer;

in response to receiving the electronic selection from the customer of the particular item of merchandise having been purchased by the customer in the prior purchase transaction, updating the customer profile associated with the customer; and

sending a notification to a merchant associated with the particular item of merchandise of the pending return, the notification identifying the customer and the particular item of merchandise.

Thus, independent Claim 32 recites certain features and operations that are similar to those recited in Applicant's independent Claim 1, which is discussed above. Accordingly, for reasons analogous to those discussed above with regard to Claim 1, Applicant submits independent Claim 32 is allowable over the proposed *Arganbright-Roman* combination.

Additionally, Applicant respectfully submits that neither *Arganbright* nor *Roman* disclose, teach, or suggest "in response to receiving the electronic request from the customer, accessing a customer profile associated with the customer, the customer profile comprising customer-specific credit information or customer-specific shipping information," as recited in Applicant's Claim 32. In the *Office Action*, and with respect to dependent Claim 5, the Examiner acknowledges that *Arganbright* does not teach "accessing a database to obtain customer information about the customer . . ." (*Office Action*, page 4). If *Arganbright* does not teach accessing a database, surely *Arganbright* cannot be said to disclose, teach, or suggest "in response to receiving the electronic request from the customer, **accessing a customer profile associated with the customer, the customer profile comprising customer-specific credit information or customer-specific shipping information**," as recited in Applicant's Claim 32. Similarly, as *Arganbright* does not disclose a customer profile, *Arganbright* also does not disclose, teach, or suggest "in response to receiving the electronic selection from the customer of the particular item of merchandise having been purchased by the customer in the prior purchase transaction, **updating the customer profile associated with the customer**," as also recited in Applicant's Claim 32.

These deficiencies of *Arganbright* are not cured by the additional disclosure of *Roman*. Although *Roman* discloses that the system "automatically analyzes the submitted return for fraud and abuse" and that one such category includes the "frequency or abuse of an

e-tailers established parameters within a specified time period" (*Roman*, paragraph 16), analyzing the frequency of a customer's return rate is not analogous to "**accessing a customer profile associated with the customer**, the customer profile comprising **customer-specific credit information or customer-specific shipping information**," as recited in Applicant's Claim 32. Similarly, analyzing the frequency of a customer's return rate is not analogous to "in response to receiving the electronic selection from the customer of the particular item of merchandise having been purchased by the customer in the prior purchase transaction, **updating the customer profile associated with the customer**," as also recited in Applicant's Claim 32.

As another example, Applicant respectfully submits that neither *Arganbright* nor *Roman* disclose, teach, or suggest "sending a notification to a merchant associated with the particular item of merchandise of the pending return, the notification identifying the customer and the particular item of merchandise," as recited in Applicant's Claim 32. In the *Office Action*, and with respect to dependent Claim 13, the Examiner states that *Arganbright* "teaches the step of notifying a merchant of the return item." (*Office Action*, page 4). However, *Arganbright* merely discloses that the "return form" includes "a comments section . . . so that the user can supply feedback to the marketing company or merchant partners." There is no disclosure in *Arganbright* of "sending a notification to a merchant associated with the particular item of merchandise of the pending return, the notification identifying the customer and the particular item of merchandise," as recited in Applicant's Claim 32. Since *Roman* does not cure these deficiencies, Applicant respectfully submits that Claim 32 is allowable over the references of record.

For at least these reasons, Applicant respectfully requests consideration and allowance of Claim 32. For analogous reasons, Applicant respectfully requests consideration and allowance of dependent Claims 29-31.

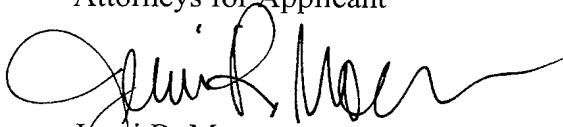
CONCLUSION

Applicant has made an earnest attempt to place this Application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests reconsideration and full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Jenni R. Moen, Attorney for Applicant, at the Examiner's convenience at (214) 953-6809.

The Commissioner is authorized to charge \$25.00 to Deposit Account No. 02-0384 of Baker Botts L.L.P. for an additional dependent claim. Although no other fees are believed due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
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